

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
SAN ANTONIO DIVISION

TRINITY UNIVERSITY,

Plaintiff,

v.

TRINITY LEARNING FOUNDATION
d/b/a TRINITY UNIVERSITY

Defendant.

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Civil Action No. 5:11-cv-00613

ORIGINAL COMPLAINT

Plaintiff, Trinity University, files this Original Complaint seeking injunctive relief and damages from Trinity Learning Foundation d/b/a Trinity University (hereinafter “Trinity Learning Foundation” or “Defendant”) based on Defendant’s infringement of Trinity University’s registered trademark TRINITY UNIVERSITY. This is an action for trademark infringement, unfair competition pursuant to the Lanham Act and Texas common law; domain name infringement; and trademark dilution pursuant to the Lanham Act and the Texas Business & Commerce Code.

JURISDICTION AND VENUE

1. The Court has jurisdiction over the federal trademark infringement, domain name infringement, unfair competition and dilution claims pursuant to 28 U.S.C. § 1331 (federal question); 28 U.S.C. § 1338(a) (trademark, domain name and unfair competition cases); and 28 U.S.C. § 1332 (diversity of citizenship). The Court has supplemental jurisdiction over the Texas common law trademark infringement and unfair competition claims, and the Texas statutory dilution claim pursuant to 28 U.S.C. § 1338(b).

2. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b) because a substantial part of the events giving rise to Trinity University's claim occurred here. As set forth in greater detail below, upon information and belief Trinity Learning Foundation is an on-line distance learning educational program that solicits enrollment from individuals in the State of Texas and has offered its services to individuals in the State of Texas and in the Western District of Texas.

THE PARTIES

3. Trinity University is a non-profit corporation chartered under the laws of Texas, with its principal place of business at One Trinity Place, San Antonio, Texas 78212.

4. Defendant, Trinity Learning Foundation, upon information and belief, is an entity created under the laws of the state of Delaware. Upon information and belief, Defendant engages and/or has engaged in business in Texas, but does not maintain a regular place of business in this state or a designated agent for service of process. Pursuant to Rule 4 of the Federal Rules of Civil Procedure, Defendant may be served with process by delivering a copy of the summons and the complaint to its registered agent, Registered Agents, Ltd., 1220 N. Market Street, Suite 804, Wilmington, Delaware 19801.

FACTS RELEVANT TO ALL COUNTS

5. Trinity University is a nationally recognized liberal arts and sciences institution noted for its exceptional faculty and commitment to the comprehensive preparation of its student body. Trinity University has been consistently ranked number one for numerous years among colleges and universities that offer a full range of undergraduate and master level programs in the western part of the United States by *U. S. News & World Report*.

6. Because of Trinity University's reputation in the educational services industry, and due to the many publications containing the TRINITY UNIVERSITY mark that are sent to current and potential students of Trinity University each year, the TRINITY UNIVERSITY mark has become well known to its customers and to the general public.

7. The TRINITY UNIVERSITY mark is distinctive in the educational services industry, and has become synonymous with high-quality education.

8. Trinity University is the owner of United States Service Mark Registration No. 1,635,763 for TRINITY UNIVERSITY to identify educational services, namely providing courses of instruction at the college level. This Registration is valid and incontestable under the provisions of Section 15 of the Lanham Act, 15 U.S.C. §1065. A copy of such registration is attached hereto as **Exhibit A**.

9. The TRINITY UNIVERSITY mark is famous within the education community in the United States.

10. Defendant Trinity Learning Foundation has adopted and used, and continues to use, without permission, the TRINITY UNIVERSITY mark, or a substantially similar mark, for and in connection with higher education. Specifically, upon information and belief, Trinity Learning Foundation has established an "Educational Division of the Foundation" which it has called "Trinity University." Trinity Learning Foundation purports to be an on-line distance learning educational entity that "confers professional certificates, diplomas and degrees to adult learners through distance learning and center based learning." As reflected on excerpts from web pages from its website at www.trinityedu.us, Trinity Learning Foundation purports to be "a credited or recognized by, or an organizational member in good standing of" the United States

Distance Learning Association and purports to be “following traditional campus based learning which are available in Connecticut, Washington, Texas, Canada, Australia and Europe” and purports to have “developed links and partnerships with a network of U.S. accredited partner universities and campuses in Arizona, California, Kansas and Wisconsin for Trinity Foundation students who wish to transfer to campus based programs in the U.S.” A copy of an excerpt from the Trinity Learning Foundation website is attached hereto at **Exhibit B**.

11. Defendant Trinity Learning Foundation has used and continues to use the name “Trinity University” prominently on its website, located at www.trinityedu.us, and in connection with its recruiting efforts across the United States. Upon information and belief, Defendant Trinity Learning Foundation has solicited and continues to solicit individuals for enrollment throughout the United States, including but not limited to individuals in Texas.

12. The name “Trinity University” used by Defendant to promote and identify educational services is confusingly similar to Trinity University’s well known TRINITY UNIVERSITY registered mark. Additionally, Trinity Learning Foundation’s use of the domain name www.trinityedu.us is confusingly similar to Trinity University’s federally registered TRINITY UNIVERSITY mark and is confusingly similar to Trinity University’s domain name www.trinity.edu. Upon information and belief, Defendant Trinity Learning Foundation adopted the domain name www.trinityedu.us with the intention of trading on Trinity University’s registered trademark TRINITY UNIVERSITY and to trade on Trinity University’s goodwill.

13. Defendant’s actions are likely to cause the public to believe that Defendant’s educational services are affiliated, connected, or associated with Trinity University, or that such educational services originate with, or are sponsored or approved by Trinity University.

Defendant's use of the name "Trinity University" also misrepresents the nature, characteristics, and/or quality of its educational services. The aforesaid actions of Defendant constitute a false designation of the origin of such educational services, and falsely describe and represent such educational services. The use by Defendant of Trinity University's mark TRINITY UNIVERSITY also constitutes an attempt to palm off and appropriate to itself Trinity University's exclusive rights therein.

14. Defendant's actions have diluted the distinctiveness of Trinity University's marks through both blurring and tarnishment. In addition, Defendant's actions are likely to cause injury to Trinity University's business reputation in the education community as Defendant's educational services are not subject to the same quality control and regulation as those of Trinity University.

15. Upon information and belief, Defendant has willfully and deliberately infringed Trinity University's registered mark. Trinity University never authorized or consented in any way to the use of its registered mark by Defendant.

16. Trinity University has been, and continues to be, damaged by the aforementioned acts in a manner that cannot be fully measured or compensated in economic terms. Defendant's acts have damaged, and threaten to continue damaging, Trinity University's reputation and goodwill and put Trinity University in a position where it cannot control its reputation and goodwill. Upon information and belief, Defendant has and will continue to engage in such unauthorized activities in this state and elsewhere in interstate commerce. Trinity University has no adequate remedy at law and will suffer irreparable harm and damage as a result of the aforesaid acts, in an amount presently incalculable. Unless Defendant is restrained by this Court

from continuing its imitation, copying, and unauthorized use of the TRINITY UNIVERSITY mark, these injuries will continue to occur.

FIRST CAUSE OF ACTION

(Infringement of Registered Trademark)

17. Trinity University realleges each allegation set forth in paragraphs 1-16 above.

18. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive and monetary relief pursuant to 15 U.S.C. § 1114 with respect to Defendant's infringement of the registered trademark.

SECOND CAUSE OF ACTION

(Violation of Section 43(a) of the Lanham Act)

19. Trinity University realleges each allegation set forth in paragraphs 1-18 above.

20. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive and monetary relief pursuant to Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), with respect to the false designation of origin and false descriptions and representations in commerce by Defendant's use of the mark TRINITY UNIVERSITY.

THIRD CAUSE OF ACTION

(Domain Name Infringement)

21. Trinity University realleges each allegation set forth in paragraphs 1-20 above.

22. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive and monetary relief pursuant to 15 U.S.C. § 1125(d)(1)(A)(ii)(I), with respect to Trinity Learning Foundation's use of the domain name www.trinityedu.us which is confusingly similar to Trinity University's federally registered TRINITY UNIVERSITY mark

and is confusingly similar to Trinity University's domain name www.trinity.edu. Upon information and belief, Defendant Trinity Learning Foundation adopted the domain name with a bad faith intent to profit from use of that mark and is using a domain name that is identical or confusingly similar to Trinity University's registered trademark TRINITY UNIVERSITY.

FOURTH CAUSE OF ACTION

(Violation of the Federal Trademark Dilution Act)

23. Trinity University realleges each allegation set forth in paragraphs 1-22 above.

24. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive and monetary relief pursuant to 15 U.S.C. § 1125(c) with respect to the dilution by blurring and dilution by tarnishment in commerce by Defendant's use of the mark TRINITY UNIVERSITY.

FIFTH CAUSE OF ACTION

(Violation of Texas Anti-Dilution Statute)

25. Trinity University realleges each allegation set forth in paragraphs 1-24 above.

26. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive relief pursuant to § 16.29 of the Texas Business and Commerce Code, with respect to the dilution by blurring and dilution by tarnishment in commerce by Defendant's use of the mark TRINITY UNIVERSITY.

SIXTH CAUSE OF ACTION

(Common Law Trademark Infringement)

27. Trinity University realleges each allegation set forth in paragraphs 1-26 above.

28. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive and monetary relief pursuant to the common law, with respect to Defendant's infringement of the registered trademark.

SEVENTH CAUSE OF ACTION

(Common Law Unfair Competition)

29. Trinity University realleges each allegation set forth in paragraphs 1-28 above.

30. By reason of the foregoing, Trinity University hereby asserts a claim against Defendant for injunctive and monetary relief pursuant to the common law, with respect to the false designation of origin and false descriptions and representations in commerce by Defendant's use of the mark TRINITY UNIVERSITY.

JURY DEMAND

31. Trinity University requests a trial by jury.

PRAYER FOR RELIEF

WHEREFORE, Trinity University prays for judgment against Defendant as follows:

- A. That Defendant Trinity Learning Foundation and its officers, agents, servants, employees and all persons in active concert or participation with them, be enjoined and restrained during the pendency of this action and perpetually from:
- (i) Using the term "Trinity University" or any other word, symbol, phrase or term, similar to Trinity University's mark TRINITY UNIVERSITY, in connection with the promotion, advertising or sale of any product or service associated with or related to educational services or products, unless expressly authorized by Trinity University;
 - (ii) Infringing Trinity University's registered TRINITY UNIVERSITY marks;
 - (iii) Using any name, phrase, symbol or term which is likely to dilute the distinctive or famous nature of Trinity University's TRINITY UNIVERSITY mark;

- B. That Defendant Trinity Learning Foundation be required to provide Trinity University with a detailed report in writing and under oath setting forth the manner in which Defendant has complied with the injunction;
- C. That Defendant Trinity Learning Foundation be adjudged to have infringed Trinity University's registered TRINITY UNIVERSITY mark and be required to pay Trinity University such damages as Trinity University has sustained or will sustain as a result of Defendant's unlawful acts and to account for all gains, profits and advantages derived by Defendant attributable to such acts;
- D. That the award of damages, gains and/or profits be increased, as provided by 15 U.S.C. § 1117, or as otherwise provided by law;
- E. That Defendant Trinity Learning Foundation be adjudged to be in violation of 15 U.S.C. § 1125(d) by having registered and used the domain name www.trinityedu.us, which is identical or confusingly similar to Trinity University's registered TRINITY UNIVERSITY mark, and has used such domain name with a bad faith intent to profit from use of that mark, and as a result Defendant Trinity Learning Foundation be required to transfer the domain name www.trinityedu.us to Trinity University;
- F. That Defendant Trinity Learning Foundation be ordered to pay over to Trinity University the costs of this action, including reasonable attorneys' fees, costs, and interest, as provided by 15 U.S.C. § 1117, or as otherwise provided by law; and
- G. That Defendant Trinity Learning Foundation be required to pay Trinity University monetary damages suffered as a result of common law trademark infringement, dilution and exemplary damages due to the malicious, fraudulent, deliberate and/or willful nature of Defendant's acts.
- H. That Trinity University be awarded such further relief as the Court may deem just and proper.

Respectfully submitted,

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By: /s/ J. Daniel Harkins

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